

which requires "Lines that are 1 ½ or double spaced" for the specification (including the abstract and claims).

Applicant further submits that correction is not required with respect to reference numerals 112 and 113. Page 4, line 12, of the instant application describes the intelligent black box 112 as used by the "on-line shopper, or "giver"". In contrast, page 4, line 27, describes "the recipient's PC or intelligent black box 113." The specification and corresponding Figure 1 clearly indicate that reference numerals 112 and 113 refer to two different intelligent black boxes. In view of the above arguments, Applicant has not made changes to the specification.

Applicant has amended the specification at page 1 to include appropriate serial numbers for related patent documents.

With respect to the objection to claims 1-10, Applicant traverses for the same reasons discussed above in reference to the line spacing of the specification.

With respect to the §112 rejection of claims 2 and 3, Applicant has amended claim 1 to provide proper antecedent basis for the "partial data sets." As this limitation was included in the originally filed application, for example, in claim 6, Applicant submits that the amendment does not add new matter.

Applicant respectfully traverses the §103 rejections as there is no correspondence between the cited references and the claimed invention. No prior art has been cited that includes for example, passing at least one image to a virtual storage closet at that site for view by the on-line viewer as claimed. The Office Action acknowledges on page 7 that neither the '769 nor the '211 reference teaches this limitation. The specification teaches various advantages for having a virtual storage closet for storing partial-data sets corresponding to different ones of the articles including reducing the amount of memory and processing required to recreate the article for view by the user. A §103 rejection cannot be maintained without evidence of complete correspondence between the cited references, therefore Applicant requests that all the rejections be withdrawn.

Applicant also respectfully traverses the §103 rejections and the Official Notices taken in connection with them. The Office Action has failed to provide references that teach or suggest the combinations regarding the modifications asserted against the claims. Should the §103 rejections be maintained, consistent with M.P.E.P §2144.03, Applicant requests corroborating

documentation in support of such alleged well known prior art as well as evidence of its combinability (under §103) with the teachings of the '769 and '211 references.

Applicant further submits that the Office Action fails to present motivation in support of the modification of the '769 reference with the '211 reference. Evidence has not been provided of any teaching or suggestion for using the '769 reference in connection with on-line viewing of an article on another structure, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., (Fed. Cir., December 6, 2000). The Office Action fails to identify any evidence of why one skilled in the art would be led to modify the '769 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the rejections be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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By: 

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Specification Changes for S/N 09/527,986

At page 1, lines 11-16, please make the following changes:

This application is based on, and claims priority to, U.S. Provisional Patent Applications, Nos. 60/159,476 and 60/167,493, respectively filed October 14, 1999 (GIAN.002P1) and November 24, 1999 (GIAN.003P1). Provisional Application No. 60/159,476 has been converted into U.S. Application No. 09/515,354 (GIAN.002PA), filed February 29, 2000, and Provisional Application No. 60/167,493 has been converted into U.S. Application No. 09/527,723 on March 17, 2000 (JARB.003PA). This application also incorporates by reference concurrently filed U.S. Patent Application No. [] 09/531,101, "Previewing Combinations Of Articles" [(JARB.06PA)] (JARB.006PA).

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Claim Changes for S/N 09/527,986

1. (*Amended*) A method for on-line viewing of an article on another structure, comprising:
 - providing a host-site accessible to an on-line viewer and web-linkable to at least one article-provider site, the article provider-site having images of articles for view via the web;
 - linking the on-line viewer to the host-site and selecting a structure in response to a command received by the on-line viewer;
 - using the host-site, linking the viewer to the at least one article-provider site and passing images from that site for view by the on-line viewer;
 - electrically closeting partial-data sets respectively corresponding to different ones of the articles; and
 - generating a new image by merging representations of the different ones of the articles with the structure by forming an image of a merged item including representations of both the structure and the selected article; and communicating the merged item electronically to another site for a selection which causes a billing to another site.

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